

### REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

At the outset, Applicants note with appreciation the indication that claim 3 would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims (Official Action at page 8).

By the above amendments, claims 3 and 11 have been canceled without prejudice or disclaimer. The subject matter of claim 3 has been incorporated into claim 1. Claims 1, 8 and 9 have been amended to correct obvious typographical and/or grammatical errors. Claim 7 has been amended for readability purposes, and now recites that the hard coat layer comprises a hardened product of a hardening resin comprising metal oxide particles, wherein the hardening resin hardens upon irradiation with an active energy beam. Support for this amendment can be found in the instant specification at least at page 12, lines 1-17. Claim 10 has been amended for clarification purposes, and now recites a device comprising a display unit and the touch panel according to claim 1. Support for this amendment can be found in the specification at least at page 113, lines 19-21.

In the Official Action, claims 1 and 7 stand objected to for the reasons set forth at page 2 thereof. This objection has been obviated by the above amendment of claim 1 in which the word "provide" has been replaced with "provided," to correct an obvious typographical error. Accordingly, withdrawal of the objection is respectfully requested.

Claims 7 and 9-11 stand rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth at pages 2 and 3 of the Official Action. The rejection of claim 11 is moot in

light of the cancellation of such claim. In addition, the rejection of claims 7 and 10 is moot in light of the above amendments to such claims.

With regard to claim 9, it appears that the Patent Office has taken the position that such claim is improper because it is "unclear if the Applicant wishes to patent a device or a process of production." However, it is clear from the language of claim 9 that such claim is directed to a process for producing the touch panel according to claim 1. Applicants respectfully submit that there is nothing improper with presenting a process claim which depends from a product claim.<sup>1</sup>

In view of the above, it is apparent that claims 7, 9 and 10 fully comply with the provisions of the second paragraph of 35 U.S.C. §112. Accordingly, withdrawal of the above rejection is respectfully requested.

Claims 1, 2, 5 and 10 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,611,299 (*Fujii et al*) in view of U.S. Patent No. 6,965,191 (*Koike et al*). Claim 4 stands rejected under 35 U.S.C. §103(a) as being obvious over *Fujii et al* in view of *Koike et al*, and further in view of U.S. Patent No. 6,400,433 (*Arakawa et al*). Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being obvious over *Fujii et al* in view of *Koike et al*, and further in view of U.S. Patent No. 6,224,976 (*Takushima et al*). Claim 8 stands rejected under 35 U.S.C. §103(a) as being obvious over *Fujii et al* in view of *Koike et al*, and further in view of U.S. Patent No. 6,261,665 (*Murata et al*).

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<sup>1</sup> The practice of presenting a process claim which depends from a product claim is well accepted by the Patent Office, as is apparent from M.P.E.P. §821.04(b), which states that "withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder." From this excerpt, it is apparent that the presentation of a process claim which depends from a product claim is not per se improper.

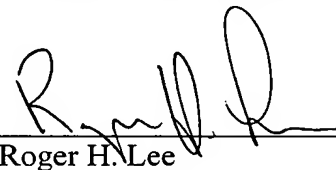
Without addressing the propriety of the Examiner's comments in connection with the above rejections, Applicants note that, in an effort to expedite prosecution, the subject matter of claim 3 has been incorporated into independent claim 1. In this regard, the Official Action at page 8 indicates that claim 3 contains allowable subject matter. Accordingly, for at least this reason, withdrawal of the above rejections is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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